

REMARKS

In the Office Action dated March 8, 2005, claims 1-12, 14-16, and 18-22 were presented for examination. Claims 1-2, 7, and 20 were rejected under 35 U.S.C. §102(e) as being anticipated by *Graf*, U.S. Patent No. 6,192,423. Claims 3-6, 8-10, 14, 15, 18, 21, and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Graf*, U.S. Patent No. 6,192,423, in view of *Graf*, U.S. Patent No. 6,317,798, and further in view of *McMullan, Jr.*, U.S. Patent No. 5,251,324. Claims 12 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Graf*, U.S. Patent No. 6,192,423 in view of the rejection of claim 1. Claims 11 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over modified *Graf* '423 and in view of *Olson*, U.S. Patent No. 6,047,319.

The following remarks are provided in support of the pending claims and responsive to the Office Action of March 8, 2006 for the pending application.

I. Rejection of Claims 1-2, 7 and 20

In the Office Action dated March 8, 2006, the Examiner assigned to the application rejected claims 1-2, 7, and 20 under 35 U.S.C. §102(e) as being anticipated by *Graf* '423. The *Graf* '423 patent pertains to a modem based communication system that utilizes a micro controller with a UART, a motherboard connected to a UART, control logic, and a multiplexer. The multiplexer selects one of the UARTs to be connected to the connector 17. "A multiplexer 16 either selects UART 13 or UART 15 to be connected to a serial connector." Col. 2, lines 56-57. However, there is no teaching in *Graf* '423 for the hardware elements, such as the control logic, micro controller, or CPU, to be formatted for headless communication.

In order for the claimed invention to be anticipated under 35 U.S.C. §102(e), the prior art, *i.e.* *Graf* '423, must teach all claimed limitations presented by the claimed invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 (citing *Verdegaal Bros. v.*

Union Oil Co. of California, 814 F. 2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)).

There is no express teaching in *Graf* '423 of a partition or a service processor formatted for headless communication. As noted by Applicant in the Specification, Microsoft Windows 2000 NT release included "a driver that enables remote input of administrative functions to a computer for both in-band and out-of-band modes. This type of operating system is often referred to as "headless"." Specification, Page 1, lines 16-18. Since there is no express teaching in *Graf* '423 for headless, it appears that the Examiner is taking the position that the "headless" feature of the claims is inherent in *Graf* '423. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). MPEP §2112. The basis and/or technical reasoning has not been provided by the Examiner. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). It is clear in the law that to support an inherent position, the Examiner must provide facts or reasoning to show that the headless element as claimed by Applicant is necessarily present in *Graf* '423. Accordingly, Applicant respectfully requests that the Examiner provide such facts or reasoning in the next communication to maintain this rejection.

Furthermore, the filing date of the *Graf* '423 patent is August 10, 1998. However, Microsoft Windows 2000 was released on February 17, 2000. See Exhibit C attached to the Response filed June 30, 2005. The *Graf* '423 patent has a filing date 1 ½ years prior to the release of Microsoft Windows 2000. As the headless format in the manner claimed by Applicant was not available prior to the February 2000 release of Windows 2000, this technology was not available to *Graf* '423 at the time of filing. In fact, when searching the records of the U.S. Patent and Trademark Office database, there are only seven patents issued by the U.S. Patent and Trademark Office that make reference to the term "headless" with a computer or computing

environment. See Exhibit D. Each of these patents have a filing date on or after January 2000. As such, it is not clear to Applicant how the *Graf* '423 patent expressly or inherently supports the headless communication as claimed by Applicant if such communication was not publicly available at the time of filing of *Graf* '423. It is Applicant's position that the Examiner has not provided the facts necessary to support a rejection based on 35 U.S.C. §102(e). Accordingly, Applicant respectfully requests that the Examiner remove the rejection of claims 1-2, 7 and 20 under 35 U.S.C. §102(e).

II. Rejection of Claims 3-6, 8-10, 14, 15, 18, 21, and 22

In the Office Action dated March 8, 2006, the Examiner assigned to the application rejected claims 3-6, 8-10, 14, 15, 18, 21, and 22 under 35 U.S.C. §103(a) as being unpatentable over *Graf* '423 in view of *Graf* '798, and further in view of *McMullan, Jr.* '324.

Applicant's remarks to *Graf* '423 made above are hereby incorporated by reference.

The *Graf* '798 patent relates to a computing environment that supports redirection requests communicated by an input device. "The distributed computing environment includes remote console 10 which initiates the redirection request via an input device 12 and displays the results of the redirection request on an output device 14. Examples of input devices 12 include, but are not limited to: a keyboard; a mouse; an electronic tablet; a touchpad; and a microphone." Col. 4 lines 45-51. Clearly, *Graf* '798 does not teach headless communication.

The *McMullan, Jr.* '324 patent relates to a system for collecting and generating viewing statistics for a television system. Commands are generated by a system manager and transmitted to set-top terminals. "Microprocessor 400 has associated NVM 470 and timing logic 480, a keyboard 400 for accepting direct inputs such as parental guidance codes, volume control and channel selection, an infrared or other remote receiver 450 for receiving remote control inputs, and a display 460." Col. 11, lines 19-23. In one embodiment, the set-up terminals may be addressable in-band or out-of-band. The in-band commands are transmitted in the video signal.

Clearly, *McMullan, Jr.* '324 does not teach headless communication.

In *Graf* '423, *Graf* '798, and *McMullan, Jr.* '324 there is no teaching, expressly or inherently, for headless communication. If support for headless communication is in any of these references, Applicant respectfully requests that the Examiner reference the evidence of such teaching. Furthermore, as noted by the Examiner with respect to claims 3, 21, and 22, *Graf* '423 is silent as to the three modes of operation as claimed, *i.e.* there is no express or inherent teaching present for these claimed limitations. *Graf* '798 is used to teach the pre-boot mode, and *McMullan Jr.* 324 is brought in by the Examiner to teach the in-band and out-of-band modes. Applicant's claims 3, 21, and 22 recite that the management commands support all three of these modes of operation.

It is accepted that for a rejection under 35 U.S.C. §103(a) to stand, there must be a suggestion or motivation in the references themselves to modify the reference or combine the teachings. See MPEP §2143. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure". MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As noted by the Examiner, *Graf* '423 "does not explicitly teach such method wherein said management commands support in-band, out-of-band, and pre-boot modes of operation." Office Action dated March 8, 2006, page 4, ¶5. *Graf* '798 "teaches pre-boot modes of operation." *Id.* *Graf* '798 "does not explicitly teach in-band or out-of band modes of operation." *Id.*, page 5, ¶1. And *McMullan, Jr.* '324 "teaches support for in-band and out-of-band modes of operation." *Id.* It is clear that the Examiner has brought in *Graf* '798 to teach the one of the modes of operation and *McMullan, Jr.* '324 to teach two of the remaining claimed modes of operation. Even if it may be ascertained that *Graf* '798 and *McMullan, Jr.* '324 combined teach the three claimed modes of operation, Applicant contends that there is no motivation in the prior art references for combining *Graf* '423, *Graf* '798 and *McMullan, Jr.* '324. Rather, the motivation for such a combination stems from the language in Applicant's claims. Clearly, *Graf* '423 is silent about the modes of operation. There is no teaching or suggestion in *Graf* '423 to modify their invention to support these modes of operation. Even if one were to combine *Graf* '423 with *Graf*

'798 as they have a common inventor and assignee, there is no support in the prior art to modify the combination of *Graf* '423 and *Graf* '798 with *McMullan, Jr.* '324 to employ all three of these modes of operation. The only support for the alleged combination stems from Applicant.

Furthermore, neither of the secondary references *Graf* '798 or *McMullan, Jr.* '324 teach headless communication in a computing environment, as claimed by Applicant. The suggested combination of *Graf* '423 with *Graf* '798 and *McMullan, Jr.* '324 would require a substantial reconstruction and redesign of the computer implemented management commands not envisioned or contemplated by *Graf* '423. Accordingly, it is Applicant's position that there is no motivation present in *Graf* '423 to be modified in the manner as claimed by Applicant.

It is clear that the Examiner is taking the elements of Applicant's pending claims and combining them in an improper manner. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Yet that is the very process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant's pending claims. There is no motivation in the prior art to combine the references, since such a combination would go against the teaching of *Graf* '423.

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusionary statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has

not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references other than that disclosed in the Applicant's specification. "The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references". *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). It is respectfully suggested that this rejection which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicant respectfully contends that the combination of *Graf* '423, *Graf* '798, and *McMullan, Jr.* '324 does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests removal of the rejection of claims 3-6, 8-10, 14, 15, 187, 21, and 22 under 35 U.S.C. §103(a).

III. Rejection of Claims 12 and 16

In the Office Action dated March 8, 2006, the Examiner assigned to the application rejected claims 12 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Graf* '423 in view of the rejection of claim 1.

Applicant's remarks to *Graf* '423 made above are hereby incorporated by reference.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP §2143.03. As noted by the Examiner, *Graf* '423 does not explicitly demonstrate "a second partition functionally analogous to the first partition." Office Action dated March 8, 2006, Page 6, ¶6. Rather, the Examiner states the "it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a second partition, . . ." *Id.* However, the law is clear regarding permissibility of an obviousness rejection where the Examiner is proposing a modification to the prior art reference. "Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432. MPEP

§2143.01. There is no teaching, suggestion or motivation in *Graf* '423 to provide at least two partitions in the manner claimed by Applicant. To expand *Graf* '423 to accommodate another partition would require significant hardware and software modifications not taught or suggested by *Graf* '423. It is therefore Applicant's position that there is no motivation present in *Graf* '423 for the modification as proposed by the Examiner. Accordingly, Applicant respectfully requests that the Examiner remove the rejection under 35 U.S.C. §103 and allow claims 12 and 16.

IV. Rejection of claim 11 and 19

In the Office Action dated March 8, 2006, the Examiner assigned to the application rejected claims 11 and 19 under 35 U.S.C. §103(a) as being unpatentable over "modified" *Graf* '423 in view of *Olson*, U.S. Patent No. 6,047,319.

Applicant's remarks to *Graf* '423, *Graf* '798, and *McMullan* '324 made above are hereby incorporated by reference.

It is not clear in the Office Action how the Examiner is defining "modified *Graf*". Applicant respectfully requests clarification from the Examiner. If the Examiner is intending to make a rejection under 35 U.S.C. §103(a), Applicant respectfully requests that the combination of references be explicitly stated in the Office Action.

As best as can be ascertained, it appears to Applicant that "modified *Graf*" is the combination of *Graf* '423, *Graf* '798, and *McMullan, Jr.* '324, wherein *Graf* '798 is brought in by the Examiner to teach the pre-boot mode, and *McMullan, Jr.* '324 is brought in by the Examiner to teach the in-band and out-of-band modes. However, the Examiner states that "modified *Graf*", which appears to be more accurately stated as *Graf* '423, in view of *Graf* '798, in view of *McMullan, Jr.* '324, does meet all of the limitations of claims 11 and 19 with respect to an Ethernet connection used for transmitting management commands. The Examiner is using *Olson* '319 to teach transmission of a command over a computer network through an Ethernet connection.

In fact, the Examiner states that *Olson* '319 is analogous art pertaining to "a headless environment." See Office Action dated March 8, 2006, page 7, ¶4. As stated above with respect to *Graf* '423, the term "headless" with respect to a computing environment is a term of art that was made available in February 2000 with the release of Microsoft Windows 2000 Operating System. Upon detailed review of *Olson* '319, Applicant could not find a teaching in *Olson* '319 for communication channels formatted for headless communication. If there is such a limitation, Applicant respectfully requests the Examiner to cite the particular column and line number. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). MPEP §2141.01. Since there is no teaching in *Olson* '319 for headless communication in a computing environment, it is Applicant's position that *Olson* '319 is not analogous art.

However, should it be determined that *Olson* '319 is analogous art, "It is accepted that for a rejection under 35 U.S.C. §103(a) to stand, there must be a suggestion or motivation in the references themselves to modify the reference or combine the teachings." See MPEP §2143. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure". MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As noted by the Examiner with respect to the rejection of claims 3-6, 8-10, 14, 15, 18, 21, and 22, *Graf* '423 "does not explicitly teach such method wherein said management commands support in-band, out-of-band, and pre-boot modes of operation." Office Action dated March 8, 2006, page 4, ¶5. *Graf* '798 "teaches pre-boot modes of operation." *Id.* *Graf* '798 "does not explicitly teach in-band or out-of band modes of operation." *Id.*, page 5, ¶1. And *McMullan, Jr.* '324 "teaches support for in-band and out-of-band modes of operation", *Id.* Now, the Examiner is suggesting that these three prior art patents can be combined and then modified to support the limitations of claims 11 and 19. Even if it may be ascertained that *Graf* '798 and *McMullan, Jr.* '324 combined teach the three claimed modes of operation, Applicant contends that there is no motivation in the prior art references for combining *Graf* '423, *Graf* '798 and *McMullan, Jr.* '324. Rather, the motivation for such a

combinations stems from the language in Applicant's claims. Furthermore, there is no motivation in the prior art references for combining *Graf* '423, *Graf* '798, *McMullan, Jr.* '324, and *Olson* '319. *Graf* '423 is silent about both the modes of operation and the headless communication. There is no teaching or suggestion in *Graf* '423 to modify their invention to support these modes of operation. Furthermore, there is no teaching or suggestion in *Graf* '798 or *McMullan, Jr.* '324 for headless communication. Even if one were to combine *Graf* '423 with *Graf* '798 as they have a common inventor and assignee, there is no support to modify the combination of *Graf* '423 and *Graf* '798 with *McMullan, Jr.* '324 to employ all three of these modes of operation. Following that same reasoning, none of *Graf* '423, *Graf* '798, or *McMullan, Jr.* '324 teach or suggest the use of an Ethernet connection to transmit management commands. The basis for such a teaching can only stem from Applicant.

It is clear that the Examiner is taking the elements of Applicant's pending claims and combining them in an improper manner. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Yet that is the very process that the Examiner has attempted to undertake, especially with the plurality of patents being used for the combination. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant's pending claims. There is no motivation in the prior art to combine the references, since such a combination would go against the teaching of *Graf* '423.

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusionary statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that

the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. If the Examiner intends to maintain this rejection, Applicant respectfully requests that the Examiner enter factual evidence into the record to support their position. It is respectfully suggested that this rejection which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicant respectfully contends that the combination of *Graf* '423, *Graf* '798, *McMullan, Jr.* '324, and *Olson* '319 does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests removal of the rejection of claims 11 and 19 under 35 U.S.C. §103(a).

V. Conclusion

There is no teaching individually in *Graf* '423, *Graf* '798, *McMullan, Jr.* '324, and *Olson* '319 for a computing environment that individually supports headless communication, as claimed by Applicant. Nor is there a motivation to combine these multiple references to teach the elements in the dependent claims, as the only basis for such a motivation stems from Applicant. It is well settled in the law of 35 U.S.C. §103(a) that the motivation must stem from the primary reference and not Applicant's invention. Even the primary reference, *Graf* '423, does not teach or suggest the limitations of Applicant's claims. It is true that the combination of the four references may provide broader connectivity for a computing environment, as suggested by the Examiner. However, there is no teaching, suggestion, or motivation to combine these prior art references to provide the broader connectivity outside of Applicant's claimed invention. Accordingly, Applicant respectfully request that the Examiner remove the rejection of claims 1-12, 14-16, and 18-20.

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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